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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,310	08/24/2001	Nao Fujita	011059	1067

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EXAMINER

WILSON, DONALD R

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,310

Applicant(s)

FUJITA ET AL.

Examiner

Donald R Wilson

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 15-35 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 and 25-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 15-24 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 6/5/03, has been fully considered with the following results.
2. The objection to the claims, the title, and the objection to new matter have been overcome by the amendment and the objections are withdrawn.
3. The amendment overcomes the rejection of claims under 35 U.S.C. § 112, first paragraph, in regards to the new matter, and this rejection is withdrawn. However the amendment is not deemed to be persuasive in overcoming the rejection under 35 U.S.C. § 112, first paragraph, concerning the scope of enablement, and this rejection is maintained for reasons discussed below.
4. The amendment also overcomes the rejection of claims under 35 U.S.C. § 112, second paragraph, and the rejection is withdrawn.
5. The amendment overcomes the anticipatory rejection over Roos and this rejection is withdrawn. However the amendment is not deemed to be persuasive in overcoming the obviousness rejection of claims over Roos in view of Nakagawa, and this rejection is maintained for reasons discussed below.

Previously Cited Statutes

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 112, First Paragraph

7. **Claims 1-3, 15-24 and 35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for purification of vinyl polymers obtained by atom transfer polymerization (ATRP), using the exemplified oxidizing agents, does not reasonably provide enablement for purifications using the scope of oxidizing agents set forth in the specification and**

claims. The basis of this rejection was stated in Detailed Action § 7 of the previous Office Action.

Applicant traverses the rejection arguing that the method of contacting vinyl polymer with an oxidizing agent is described in the specification and that there are several specific examples. This is not deemed to be persuasive because it does not address the merits of the stated rejection. The rejection is not

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based upon lack of enablement, but rather the scope of what is enabled relative to what is being claimed.

Claim Rejections - 35 USC /§ 103(a)

8. ***Claims 1-3, 15-24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roos in view of Nakagawa.*** The basis of this rejection was stated in Detailed Action § 16-19 of the previous Office Action.

9. Applicant traverses the rejection arguing that neither Roos nor Nakagawa suggest the desirability of the combination of the references. This is not deemed to be persuasive because the issue is not whether Reference A and B specifically teach that they should be combined. The issue is whether one of ordinary skill in the art, confronted with the combined teachings of References A and B would have found their combination obvious. If it can be logically deduced that the reference will imply something to one of ordinary skill in the art that the reference does not come right out and say, then logical reasoning will make that reference evidence for its implicit disclosure, as well as for its explicit disclosure.

"In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonable be expected to draw therefrom." *In re Preda*, 159 USPQ 342 (CCPA, 1968).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998).

In the instant situation it is believed that one of ordinary skill in the art confronted with the teachings of both Roos and Nakagawa would have found their combination obvious for the previously stated reason.

10. Applicant has also argued that a *prima facie* obviousness requires a reasonable expectation of success and that "obvious to try" does not establish *prima facie* obviousness. This is not deemed to be persuasive because applicant has offered no reason as to why one of ordinary skill in the art would not have a reasonable basis to expect that purification procedure disclosed by Roos to overcome the discoloration problems known to exist with ATRP polymers containing catalyst residues, would be applicable to the ATRP polymers taught by Nakagawa. It is established patent law that "obviousness does not require absolute predictability". *In re Miegel* 159 USPQ 716. *Prima facie* obviousness requires only that a reasonable expectation of success exist; absolute predictability is not required. *In re O'Farrell* 7 USPQ 2d 1673.

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Objection to Claims

11. Claim 31 is objected to because of the following informalities: The word "obtained" should not be underlined. Appropriate correction is required.

Action Is Final

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

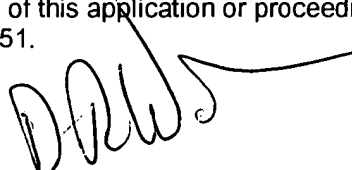
14. This application contains Claims 4-6 and 25-34 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



Donald R Wilson
Primary Examiner
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